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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/737,459 | 12/14/2000 | Robert M. Brody | 42364/207149 | 1914 |
| 23370 | 7590 | 04/26/2005 | EXAMINER | |
| JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309 | | | | KARMIS, STEFANOS |
| ART UNIT | | PAPER NUMBER | | |
| | | 3624 | | |

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| <i>Office Action Summary</i> | Application No. | Applicant(s) |
|------------------------------|-----------------|--------------|
| | 09/737,459 | BRODY ET AL. |
| Examiner | Art Unit | |
| Stefano Karmis | 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 January 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-22 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

1. The following communication is in response to Applicant's election of claims filed 12 January 2005.

Status of Claims

2. Claims 1-22 were elected for examination. Therefore claims 1-22 are under prosecution in this application.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the preamble or the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological

basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

A suggested preamble for claim 1: "A computer implemented method for providing a...." or something similar.

A suggested change to the body of claim 1: "electronically receiving a request..." or "receiving over a network, a request..." or something similar.

Similar amendments to independent claims 7 and 17 are also required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4-10 and 12-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (hereinafter Walker) U.S. Patent 6,088,686.

Walker discloses a method for providing a consumer with personalized credit-related information based on credit history data of the consumer, comprising: creating an account with the consumer (column 10, lines 50-67); receiving a request from the consumer for personalized credit-related information (column 13, lines 3-12); transmitting to a credit bureau, in response to the request from the consumer (column 6, lines 25-39), an inquiry for credit history data relating to the consumer (column 12, line 35 thru column 13, line 19); receiving credit history data on the consumer in response to the inquiry (column 13, lines 30-47), generating a summary report of personalized credit-related information based on the credit history data, the summary report including a credit score and an explanatory statement suggesting steps to improve the credit score; and transmitting the summary report to the consumer (column 11, line 45 thru column 12, line 18).

Claim 2, wherein creating an account includes establishing an agent relationship with the consumer (column 10, lines 50-67).

Claim 4, wherein generating the summary report includes generating the credit score based on the credit history data (column 11, line 45 thru column 12, line 32).

Claim 5, receiving consumer-related records from a plurality of databases on one or more networks, and wherein generating the credit score includes generating the credit score based on the credit history data and at least one of the consumer-related records which is associated with the consumer (column 11, line 45 thru column 12, line 32).

Claim 6, wherein receiving the request of the consumer includes authenticating the consumer (column 14, lines 17-27).

Regarding independent claim 7, Walker discloses a method of providing one or more pre-approved offers to a consumer based on credit-related information of the consumer, comprising: creating an account with the consumer (column 10, lines 50-67); transmitting to a credit bureau an inquiry for credit history data relating to the consumer (column 6, lines 25-39 and column 12, line 35 thru column 13, line 19); receiving credit history data on the consumer in response to the inquiry (column 13, lines 20-47); and selecting a pre-approved offer from a plurality of offers from multiple merchants based at least partially on the credit history data of the consumer (column 13, line 65 thru column 14, line 16).

Claim 8, presenting the offer to the consumer, wherein the offer is for establishing a credit-based account with a merchant (column 13, lines 2-12 and column 13, lines 65 thru column 14, line 10).

Claim 9, wherein presenting the offer includes displaying a selectable item on a webpage viewable by a web browser interface (column 5, line 65 thru column 6, line 15).

Claim 10, wherein identifying the pre-approved offer includes: receiving an offer from a merchant with merchant define criteria for selection of a suitable consumer; and selecting the offer based at least partially on the criteria provided by the merchant (column 6, lines 40-64).

Claim 12, wherein the step of creating the account includes receiving preference criteria from the consumer (column 11, line 65 thru column 12, line 18).

Claim 13, wherein selecting the pre-approved offer includes selecting the pre-approved offer from a merchant based at least partially on the preference criteria of the consumer (column 13, lines 13-64).

Claim 14, wherein selecting the pre-approved offer includes selecting the pre-approved offer from a merchant based at least partially on market activity of the consumer (column 13, lines 13-64).

Claim 15, wherein selecting the pre-approved offer includes determining a financial term of the pre-approved offer based at least partially on the credit history data of the consumer (column 13, lines 13-64).

Claim 16, further comprising selecting a plurality of pre-approved offers for the consumer based at least partially on the credit history data of the consumer and a subject preference provided by the consumer (column 13, line 65 thru column 14, line 17).

Regarding independent claim 17, Walker discloses a method for presenting pre-approved offers to a consumer, comprising: receiving consumer data records from a plurality of databases (column 12, line 35 thru column 13, line 2); selecting for the consumer at least one pre-approved offer based on at least one consumer data record associated with the consumer; and sending a web-based representation of the pre-approved offer to the consumer (column 13, line 13 thru column 14, line 17).

Claim 18, wherein receiving the consumer data record includes receiving at least one of credit history report associated with the consumer and at least one consumer data record associated with the consumer (column 12, line 35 thru column 13, line 14).

Claim 19, wherein selecting the pre-approved offer includes selecting the pre-approved offer based at least partially on the credit history record (column 13, line 48 thru column 14, line 17).

Claim 20, receiving an offer acceptance indication from the consumer in response to the representation of the pre-approved offer (column 13, line 65 thru column 14, line 17).

Claim 21, selecting the pre-approved offer includes determining a financial term of the pre-approved offer (column 13, lines 13-64).

Claim 22, selecting the pre-approved offer includes comparing at least one consumer data record with modeling criteria provided by the merchant column 14, lines 46-67).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 3 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (hereinafter Walker) U.S. Patent 6,088,686.

Claim 3, Walker teaches transmitting the inquiry to a credit bureau (column 6, lines 25-39). Walker fails to teach transmitting an inquiry includes transmitting a Fair Credit Reporting Act Consumer Inquiry for the consumer to the credit bureau. Official Notice is taken that Fair Credit Reporting Act Consumer Inquiry is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Walker and include transmitting a Fair Credit Reporting Act Consumer Inquiry because it is an efficient manner to get an accurate reflection of a consumer's credit.

Claim 11, Walker teaches pre-approved offers that are approved by the customer (column 13, line 65 thru column 14, line 17). Walker fails to teach presenting the pre-approved offer includes presenting the pre-approved offer for acceptance by the consumer, wherein the pre-approved offer is anonymously pre-approved based on a comparison of the credit history data of the consumer and the criteria provided by the merchant. Official Notice is taken that pre-approving offers anonymously is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Walker and include pre-approving offers anonymously because it provides an efficient manner to submit offers without providing excessive information, which could be used for deciphering trends amongst participants.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
06 April 2005



HANI M. KAZIMI
PRIMARY EXAMINER